

REMARKS/ARGUMENTS

The claims have been divided into Groups as follows:

- Group I: Claims 1-6, in part, drawn to processes of making compounds of formula (II), wherein the variable  $R^1$ - $R^3$  independently do not represent heterocycle, the variable  $R^1$ - $R^3$  independently are not substituted with heterocycle.
- Group II: Claims 1-6, in part, drawn to processes of making compounds of formula (II), wherein the variable  $R^1$  represents 3-furyl, 2 or 3-thiophenyl, 2 or 3-pyrrolyl or diomethylpyrrolyl thereof, the variables of  $R^2$ - $R^3$  independently do not represent heterocycle, the variable  $R^2$ - $R^3$  independently are not substituted with heterocycle.
- Group III: Claims 1-6, in part, drawn to processes of making compounds of formula (II), containing compounds not encompassed in Groups I-II.
- Group IV: Claims 7-6, drawn to processes of making carboxyphosphine compounds.
- Group V: Claim 10, in part, drawn to processes of making compounds of formula II.
- Group VI: Claim 11, drawn to products.

Election of a single specie completely defining a compound to be used for search purposes is also required.

Applicants elect, with traverse, Group I, Claims 1-6, (drawn to compounds of formula (II), wherein the variables  $R^1$ - $R^3$  independently do not represent heterocycles) for examination.

As a single disclosed specie, for examination purposes only, Applicants elect the compound of formula (II) wherein  $R^2$  and  $R^3$  are both phenyl and  $R^1$  is 2,4,6-trimethylphenyl as prepared in Example 2 of the specification.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (MPEP §803). The burden is on the Examiner to provide reasons and/or examples to support any conclusion in regard to patentable distinction (MPEP §803).

Moreover, when citing lack of unity of invention in a national stage application, the Examiner

has the burden of explaining why each group lacks unity with each other group specifically describing special technical features in each group (MPEP § 1893.03(d)).

The Examiner has asserted that Groups I - VI do not relate to a single general inventive concept under PCT Rule 13.1 because under PCT Rule 13.2, they lack a significant structural element qualifying as a special technical feature that defines a contribution over the prior art. The examiner has cited Leppard et al. (U.S. 5,399,770).

Annex B of the Administrative Instructions under the PCT at (b) Technical Relationship states:

“The expression “special technical features” is defined in Rule 13.2 as meaning those technical features that defines a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any).”

Applicants respectfully submit that the Examiner has not provided any indication that the contents of the claims interpreted in light of the description was considered in making the assertion of a lack of unity and therefore has not met the burden necessary to support the assertion.

MPEP § 1850 (B) “*Markush Practice*” states:

“When the Markush grouping is for alternatives of chemical compounds, they shall be regarded as being of similar nature where the following criteria are fulfilled:

- (A) All alternatives have a common property or activity; and
- (B)(1) A common structure is present, i.e., a significant structural element is shared by all the alternatives;”

Applicants respectfully submit that in the above identified application, the compounds of formula (II) in Claim 1 do have the common property as defined in Claim 11 and therefore meet criterion (A).

Relative to criterion (B)(1) MPEP § 1850 (B) defines “significant structural element is shared by all the alternatives” as “cases where the compounds share a common chemical

structure which occupies a large portion of their structures.” Moreover the PCT in the PCT International Search and Preliminary Examination Guidelines provide guidance in this matter through example analysis. Applicants respectfully submit that Examples 18 and 19 on pages 84 and 85 of the document are suitable references relative to analysis of formula (II). Applicants submit that the compounds of formula (II) all share the common structure of an acyl phosphine oxide indicated in formula (II) and that this common structure occupies a sufficiently large portion of the structure to meet criterion (B)(1).

Because the compounds of formula (II) meet the criteria of (A) and (B)(1) above, Applicants submit that the claims of the above-identified application relate to a single general inventive concept under PCT Rule 13.1 and therefore unity of invention is not lacking.


Applicants respectfully traverse the Restriction Requirement on the grounds that no adequate reasons and/or examples have been provided to support a conclusion of patentable distinctness between the identified groups.

For the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Withdrawal of the Restriction Requirement is respectfully requested.

Applicants submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

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